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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,673	02/18/2004	Kiyoaki Doshida	19546.0057	8536

23517 7590 08/18/2006  
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EXAMINER

PONIKIEWSKI, TOMASZ

ART UNIT PAPER NUMBER

2165

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/779,673	DOSHIDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tomasz Ponikiewski	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 18 February 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-12 are pending. Response to preliminary amendment filed on 18 February 2004 is acknowledged.

### ***Claim Objections***

2. Claims 1-2, 6, and 9-12 are objected to because of the following informalities.

Claims 1-2, and 9-12 recite the word "for" in the claims. It indicates intended use and as such does not carry patentable weight. The word could be changed to recite "to". The limitations following the phrase "for" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "for" do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form. For example, claim 1 recites "apparatus for searching for" should be "apparatus to search" or "apparatus that searches".

Claim 6 is objected to because of the following informalities: the claims contain "one of" statements. When there are "one of" statement present is signifies a choice of action, as such some parts of the invention may not be actually implemented. Appropriate correction is required.

Claims 1-2, 6, and 9-12 are objected to because of the following informalities: the claims contain "or" statements. When there are "or" statement present is signifies a choice of action, as such some parts of the invention may not be actually implemented. For example in claim 1 line 9 the "or" statement gives assumption that either music title or artist name would be chosen.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, and 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2, and 9-12 recite the phrase "predefined WWW server". It is unclear to the examiner what the applicant means by predefined WWW server thus making it vague and indefinite.

Claims 1-2, and 9-12 recite the phrase "predefined processes". It is unclear to the examiner what the applicant means by predefined processes thus making it vague and indefinite.

Claim 3 recites the phrase "predetermined interval". It is unclear to the examiner what the applicant means by predetermined interval thus making it vague and indefinite.

Claims 1-2, and 9-12 recite the phrase "given". It is unclear to the examiner what the applicant means by the recitation thus making it vague and indefinite. Who is giving, how is it done?

Claims 1-2, and 9-12 are objected to because of the following: the terms "its" and "it are vague and indefinite. It is unclear to the examiner what the terms refer to.

Claims 1-2, and 9-12 recite the limitation "the frequency" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-2 recite the limitation "the corresponding genre names" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-2 recite the limitation "the given music titles" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-2, and 9-12 recite the limitation "the predefined WWW server" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-2, and 9-12 recite the limitation "the music". There is insufficient antecedent basis for this limitation in the claim.

Claims 1-2 recite the limitation "said extracted genre names" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claims 1-2, and 9-12 recite the limitation "said WWW server" in the body of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claims 2, 10, and 12 recite the limitation "the predefined processes" in the body of the claims. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the predetermined interval" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "said genre list database" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claims 7 and 8 recite the limitation "said predefined process" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the process" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the text-to-speech" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 9-10 recite the limitation "the steps" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 9-12 recite the limitation "the genre names" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 9-12 recite the limitation "the music titles" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Leeke et al. (US 6,587,127 B1)

As per claims 1, 9 and 11 Leeke et al. is directed to searching for recommended music in the internet for a listener, the apparatus comprising:

a genre list memorizing means for storing information of a given music genre list (column 19, lines 66-67; column 20, lines 1-2);

a selection history memorizing means for storing the frequency of a selected radio station, broadcast music titles and artist names (column 9, lines 18-19; column 19, lines 25-26);

an artist's genre memorizing means for storing given music titles and corresponding artist names and its genre names (column 20, lines 7-11);

a selected-genre extracting means for extracting the corresponding genre names to the given music titles or artist names in said selection history memorizing means, by using said artist's genre memorizing means, wherein said extraction is initiated by receiving a request for internet-search (figure 22; column 30, lines 25-26; column 41, lines 40-41; column 50, lines 41-45);

a search request means for sending a search request to the predefined WWW server to download the music, with searching keyword of the genre names which are included in said genre list memorizing means, but which are not included in said extracted genre names by said extracting means (column 4, lines 51-52, column 4, lines 65-67);



and a result display means for receiving a search result from said WWW server, and displaying it on the apparatus (figure 23, column 21, lines 54-55).

As per claims 2, 10 and 12 Leeke et al. is directed to searching for recommended music in the internet for a listener, the apparatus comprising:

a genre list memorizing means for storing information of a given music genre list (column 19, lines 66-67; column 20, lines 1-2);

a selection history memorizing means for storing the frequency of a selected radio station, broadcast music titles and artist names (column 9, lines 18-19; column 19, lines 25-26);

an artist's genre memorizing means for storing given music titles and corresponding artist names and its genre names (column 20, lines 7-11);

a selected-genre extracting means for extracting the corresponding genre names to the given music titles or artist names in said selection history memorizing means, by using said artist's genre memorizing means, wherein said extraction is initiated by receiving a request for internet-search (figure 22; column 30, lines 25-26; column 41, lines 40-41; column 50, lines 41-45);

a search request means for sending a search request to the predefined WWW server to download the music, with searching keyword of the genre names which are included in said genre list memorizing means, but which are not included in said extracted genre names by said extracting means (column 4, lines 51-52, column 4, lines 65-67);

a result display means for receiving a search result from said WWW server, and displaying it on the apparatus (figure 23, column 21, lines 54-55);

and a processing means for processing said search result from said WWW server, by using the predefined processes (column 8, lines 45-47).

As per claim 3 Leeke et al. is directed to said request for internet-search is automatically sent to said extracting means, when radio listening time becomes over the predetermined interval (figure 22; column 20, lines 54-57; column 30, lines 25-26; column 41, lines 40-41; column 50, lines 41-45).

As per claim 4 Leeke et al. is directed to said request for internet-search is automatically sent to said extracting means, when the apparatus fails to find any receivable radio station (figure 22; column 8, lines 38-39; column 20, lines 54-57; column 30, lines 25-26; column 41, lines 40-41; column 50, lines 41-45).

As per claim 5 Leeke et al. is directed to said request for internet-search is automatically sent to said extracting means, when the apparatus has executed all radio station selection within all receivable radio stations (figure 22; column 13, lines 49-60, wherein when station playing is eliminated from selection, apparatus plays next stations found; column 30, lines 25-26; column 41, lines 40-41; column 50, lines 41-45).

As per claim 6 Leeke et al. is directed to one or more of the genre names of "classic", "jazz", "rock" and "pops" is included in said genre name in said genre list database or in said artist's genre means (column 20, lines 1-2).

As per claim 7 Leeke et al. is directed to said predefined process of said processing means is the process to replay a sound-source file (column 8, lines 45-47).

As per claim 8 Leeke et al. is directed to said predefined process of said processing means is the text-to-speech reading process (column 8, lines 12-15, wherein books and speeches could be read).

### ***Conclusion***

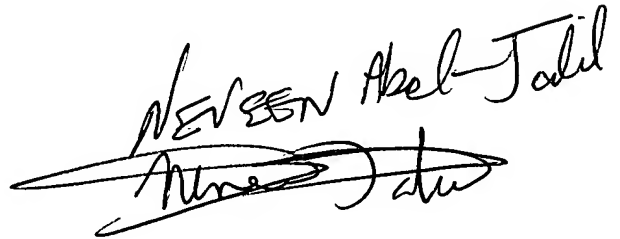
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2165

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski  
August 11, 2006

A handwritten signature in black ink, reading "NERVEN Akel-Jalil". The signature is written in a cursive style with a large, sweeping horizontal stroke underneath the name.